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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,545

01/23/2006

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EXAMINER

PAGONAKIS, ANNA

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

04/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,545	<b>Applicant(s)</b> MARQUAIS-BIENEWALD ET AL.	
	<b>Examiner</b> ANNA PAGONAKIS	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) 25-27 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24, 29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's amendment filed 1/7/2009 has been received and entered into the present application.

Claims 22-27 and 29-31 are pending. Accordingly, claims 25-27 and 30 remain withdrawn, claim 22 is currently amended

Applicant's arguments, filed 1/7/2009 have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

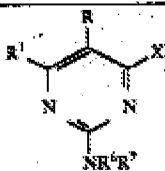

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22-24, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunley et al. (US 4,116,674) and Ghoneim (J. Indian Chem. Soc. Oct. 1986, pp.914-917, provided by Applicant).

Sunley et al. teach the use of a similar compound to that elected by Applicant (please refer to Table 1, bridging columns 3-4):

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TABLE I-continued					
					
COMPOUND NO	R <sup>1</sup>	R	X	—NR <sup>6</sup> R <sup>7</sup>	
45	CH <sub>3</sub>	CH <sub>3</sub>		NHCH <sub>3</sub>	33-31

Though the alkyl chain, on position NR<sub>6</sub>R<sub>7</sub> on the Table above is not the same chain length as the one provided by applicant (C<sub>8</sub>H<sub>18</sub>), the change of alkyl chain length is well within the purview of the skilled in the art, 84 USPQ 458 and 81 USPQ 383.

Ghoneim et al teach that 2,4-di-substituted-6-methylpyrimidine such as the elected compound, are well known for the effective treatment of antimicrobials (see page 914, column 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to administer the elected compound of Sunley et al., in view of the desirable results obtained and disclosed by Ghoneim (abstract), one of ordinary skill in the art would reasonably expect elected compound found in Sunley et al. to successfully promote an antimicrobial treatment. Such a modification would have been motivated by the reasonable expectation that a known 2,4-di-substituted-6-methylpyrimidine would effective antimicrobial treatment. Further, it would be reasonable to expect that the elected compound would be equally effective in carrying out the therapeutic method of Ghoneim.

Concerning the claimed use on a plastic, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claims.

*Applicant's Remarks*

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Applicant alleges that Ghoneim et al teaches many biological activities including antimicrobial, fungicidal and insecticidal activities and as such fails to direct one to the antimicrobial treatment of plastic surfaces with specific compounds. Further, Applicant states that one of the tested compounds exhibited no antimicrobial activity. Applicant alleges that there is no general expectation that a herbicide will also act as an antimicrobial for plastic surfaces.

*Response to Applicant's Arguments*

Applicant's amendments and remarks have been carefully considered in their entirety, but fail to be persuasive in establishing error in the propriety of the present rejection.

Applicant appears to be of the persuasion that, because Ghoneim et al disclose biological activities in addition to the one instantly claimed (i.e. antimicrobial activity), this somehow constitutes a complete lack of teaching of the claimed compound and/or constitutes a teaching away from the instantly claimed compound. This is not persuasive. A preferred or exemplified embodiment does not constitute a teaching away from other embodiments disclosed within the four corners of the reference, including non-preferred embodiments. Applicant is reminded that the disclosure of a reference must be considered as expansively as is reasonably possible to determine the full scope of the disclosure and, as a result, is most certainly most limited to that which is preferred and/or exemplified. Thus, the fact that other biological activities may be exemplified, claimed and/or preferred does not negate or direct the artisan away from the broader teaching of the reference, which expressly provides for, and, thus, clearly contemplates the use of, the compounds as antimicrobials. A reference will constitute a teaching so long as the disclosure clearly describes and enables such an embodiment, which, in the present case, such description is clearly found in Ghoneim et al.

The fact that the reference may teach embodiments that differ from Applicant's own invention does not negate, or teach away from, the teachings of the reference as a whole and what the reference as a whole would have reasonably suggested to one having ordinary skill in the art at the time of the invention.

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Further, picking and choosing elements from a reference, that differ from those upon which the Examiner relies in support of the rejection as a means for discounting the anticipate made by the Examiner is not persuasive when Applicant does not clearly acknowledge and address the pertinent teachings of the reference upon which the rejection is based, specifically, the disclosure found in Ghoneim et al, which clearly teachings the compound discussed in the body of the previous rejection.

Secondly, Applicant alleges that one of the compound tested in Ghoneim et al does not exhibit antimicrobial activity. It is noted that there only be a reasonable expectation of success and absolute predictability by the art is not required. Given that the remaining plethora of compounds exhibited antimicrobial activity, a reasonable expectation of success is present as is the standard for obviousness.

With regard to Applicant's allegation that there is no general expectation that a herbicide will also act as an antimicrobial for plastic surfaces, Applicant advances no specific reason or evidence, aside from Counsels' own speculation, in support of this position. This assertion by Counsel is an unsupported allegation and fails to take place of evidence in the record. Statements of this nature are clearly unpersuasive in accordance with guidance provided at MPEP 2145, which states, "The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602 145 USPQ 716, 178 (CCPA 1965); In re Geisler 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)."

With regard to Applicant's newly added limitation of a surface coating composition in claim 22, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Finally, Applicant is again reminded that rejections made under 35 U.S.C. 103(a) are based upon the combination of references. As a result, focusing solely on the discrete teachings of each of the cited references is tantamount to examining each of them inside of a vacuum and fails to be persuasive in establishing non-obviousness, not each individual reference alone. In other words, it must be

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remembered that the references are relied upon in combination and are not meant to be considered separately. To properly conclude obviousness of an invention does not require the claimed invention to be expressly suggested in its entirety by any one single reference under 35 U.S.C. 103(a). Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

### **Conclusion**

No claim is found to be allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614